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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,706	06/21/1999	SUMIYO OKADA	21.1924/JRB	7969
21171	7590	09/21/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PRIETO, BEATRIZ	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/336,706

Applicant(s)

OKADA ET AL.

Examiner

Prieto B

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 13-35 is/are pending in the application.
- 4a) Of the above claim(s) 13-15 and 18-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 16-17 and 26-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) e  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This communication is in response to amendment filed 05/11/04, currently claims 4-12 are cancelled, and claims 13-15, 18-25 are withdrawn from consideration, claim 1 has been amended, claims 26-35 have been added. Pending claims are 1-3, 16-17 and 26-35 and further 13-15 and 18-25 were withdrawn from consideration

***Claim Rejection under 35 U.S.C. 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. According to 37 CFR 1.53 (c) No new matter may be introduced into an application after its filing date.

Regarding amendment to the claims, the added claim limitation as been given full consideration and found to be not supported by the disclosure as originally filed. In case, the specification has been carefully reviewed for a description associated with the added limitation stating that *each chat network has one or more servers* providing independent chat communication service to chat neither client nor where a chat network is designated as a current destination. The specification as originally filed has been reviewed and found to make mentioned to the term "server" in one instance on the background, that is, "Moreover, in the exemplified chat system, when different users are presented on the main server, individual connections for each user are required", see page 3, lines 20-23, other recitation of the term server are not found. Further, it is not clear where in applicants disclosure that the chat client communicates with two chat networks *concurrently over a period of time*. Thereby, the above-mentioned added limitation is not found to be supported by applicant's disclosure.

4. Claims 26 and 27, rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In this case, these claims recite a negative limitation (i.e. "where different channels do not share messages" and "chat messages are not exchanged between the two chat

networks”, respectively. Negative limitation(s) require that the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Limitations should not define the invention in terms of what it was not, or excluding what the inventors did not invent rather than distinctly and particularly point out the invention. In *re Schechter*, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims (see MPEP 2173.05(i). See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation, which does not have basis in the original disclosure, should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicant is urged to point supportive disclosure. Applicant is urged to point out supportive disclosure pertaining this limitation.

5. Applicant’s remarks regarding the definition of the term “chat network” has been fully considered and addressed below in the response to argument section of this office action.

6. For the purpose of examination, the added claim limitation would be examined in light of the specification (see MPEP 2111). Further for the purposes of accelerating prosecution, examiner will provide an indication (below) of subject matter and/or features from the specifications that may be introduce in the claim language to overcome the prior art of record.

7. Claim interpretation, according to applicant’s disclosure: a chat network is a unit of service provided to the user (see p. 8, lines 1-5); a common field is a common network and also a common channel, which is a conversation, i.e. communication between two persons (p. 3, lines 7-15); a channel is a common field (p. 9, lines 6-8); a display area is used to display or represent a channel (p. 8, lines 16-22); a field communication is defined as a channel (e.g. main or sub-channel), where the content of the message can be identified or represented through respective displays, on different display areas (p. 2, lines 14-20); and a one-to-one conversation is possible be providing an individual common communication field (one common network) for each conversation user (p. 2, lines 28-32).

***Claim Rejection under U.S.C. 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 16-17, 28-33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over REDPATH et. al. U.S. Patent No. 5,990,887 in view of in view of MONCREIFF U.S. Patent No. 5,828,839.

Regarding claim 1, Redpath teaches a method including a ("chat client") user's terminal (100 or 110 of Fig. 2) in a ("information exchange") system (8 of Fig. 1) (abstract) for transmitting and receiving messages (col 1/lines 15-20, and col 2/lines 20-26) through two ("chat networks") communication means to transmit and receive the messages by the terminal (col 3/lines 3-13 and Fig. 2), the system comprising:

designation means (100 of Fig. 2) designating at a chat network of the plurality of chat network as an active chat network for receiving messages transmitted by a user terminal (col 3/lines 3-13 and Fig. 2);

obtaining with the user terminal (100/110 of Fig. 2) the messages at least some of which are transmitted to or received from one of the chat networks and at least some of which are transmitted to or received from another of the chat networks (col 3/lines 3-32, Figs. 6A-C); and

displaying with the user's terminal the obtained messages transmitted to the two chat networks in ("first discrete display") an area independent of a message display area of each the two chat networks (602, 608, 616, 622 of Fig. 6A, col 3/lines 3-32 and col 4/line 37 to col 5/line 12);

wherein the chat client is configured transmit and receive the messages through one host server that provides chat communication service to chat clients (Redpath: col 2/lines 20-25, see Internet service provider (ISP), i.e. a server col 1/lines 15-27), where the chat communication service to chat clients is independent (Redpath: Fig. 6 illustrates an independent chat communication service to the chat client, in that the message (602) by chat client (600) received by chat clients (610) and (620), and the message (608) sent by same client (602) does not affect message (604) message sent by two chat client or vice-versa), however Redpath does not explicitly said communication is concurrent in a period of time

Moncreiff teaches a system/method related to chat rooms accessible over the Internet, discussing as prior art, where multi-users simultaneously connected to a host computer site, can send and received

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messages over the network, where the message are displayed among the user, this conversational dialogue in real-time (col 1/lines 23-40).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the suggestion of Redpath for conducting on-line chat conversation to conduct conversational dialogues with other users around the globe concurrently over the period of time while, specifically, while the users are connected to the host computer site that exchanges and relays the messages in the chat communication, as discussed by the Moncreiff reference further exemplifying this aspect as existent in current chat environments.

Regarding claim 16, Redpath teaches displaying messages of both chat networks in independent areas (602, 608, 616, 622 of Fig. 6a, col 3/lines 3-32 and 4/line 37-col 5/line 12).

Regarding claim 17, ("discrete display") area is separate from another display area that is dedicated to the ("active chat") network communication (col 4/lines 37-col 5/line 12 and 3/lines 3-13 of Figs. 3 and 6).

Regarding claim 28, chat networks are different, where the messages are identified according to the logical network, i.e. service of the sender (Redpath: Fig. 6 illustrates different chat networks 602, 612 & 614).

Regarding claim 29, displaying on the client (600) obtained messages in a first discrete area, i.e. a window (Redpath: 600 of Fig. 6) is independent from the message display area (Redpath; 610 or 620 of Fig. 6) of the plurality of chat networks.

Regarding claim 30, this is the computer readable implementation associated with claim 1, same rationale of rejection is applicable.

Regarding claims 31 and 35, this claim is substantially the same as claim 1, thereby same rationale of rejection is applicable.

Regarding claim 32, this claim is substantially the same as claim 29, same rationale of rejection is applicable.

Regarding claim 33, this claim comprises limitations and/or features recited on claim 1, in that the information exchange transmits/receiving messages sent concurrently over a period of time, i.e. “interspersedly transmitted”, same rationale of rejection is applicable.

***Claim Rejection under U.S.C. 102***

10. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

11. Claims 2-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Redpath et. al. U.S. Patent No. 5,990,887 (Redpath hereafter)

Regarding claim 2, Redpath teach substantial features of the invention as claimed, teaching (“information exchange”) system in which user terminals (12/30 of Fig. 1 or 110/100 of Fig. 2) are configured for connection to a plurality of network communication sessions (“chat networks”) to transmit and receive messages through the plurality of chat networks (col 3/lines 3-13, 38-41 and 49), the user terminals having a (“message display”) area (Fig. 3) for displaying messages transmitted (Fig. 6A, elements 602, 608, 616, 622) and received (Fig. 6A, elements 604, 606) to or from each of the plurality of chat networks (col 3/lines 14-32), the information exchange system comprising:

designation means (100 of Fig. 2) (“designating”) establishing a (“chat network”) network communication or session of the plurality of chat networks as an (“active chat network”) current network communication or session for receiving messages transmitted by a user terminal (col 3/lines 3-13 and Fig. 2); and

message acquiring means (100 of Fig. 2) of the user terminal for acquiring messages transmitted and received to or from each the plurality of chat networks (col 3/lines 3-13 and col 4/lines 37 to col 5/line 12); and

message displaying means (100 of Fig. 2 and Figs. 3 and 6) of the user terminal for displaying the acquired messages in a (“discrete display”) area independent of a (“message display”) area of each of the plurality of chat networks (col 4/lines 37-col 5/line 12 and 3/lines 3-13).

Regarding claim 3, message transmission cooperating means (100/110 of Fig. 2) of the user terminal for transmitting a message when the messaged edited and displayed on a designated area independent from

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the other designated areas on the screen is identified for transmission by pressing the enter causing the displayed message displayed on a designated area to be transmitted to recipient on at least one of the plurality of network (col 4/lines 36-col 5/line 12).

***Response to arguments***

12. Applicant's arguments filed 05/11/04 have been fully considered but not rendered persuasive.

13. Applicant's remarks regarding the definition of the term "chat network" has been fully considered. Applicant has indicated that on page 7, lines 31-35 and page 8, lines 2-25 of the specification the term is clearly defined and consistent with the chat terminology. These portions are hereby presented: "Fig. 2 illustrates an example of a display image display image displayed on the display apparatus 11. The display areas 300 and 310 are examples of the image displayed by the chat system 30. Since display areas 300 and 310 are connected to the service offering users of the two chat systems, two windows on the display area 300 are displayed by the chat system 30. The chat system 30 is connected to the IRC network A, and the display area 310, also displayed by the chat system 30, is similarly connected to the IRC network B and displayed on the display apparatus 11. In this example, *the IRC network is defined as a logical network formed in units of services offered to user of the chat system 30, and different from a physical network.*". The specifications is clear with respect to a definition, however Applicant sustains that this definition is consistent with a definition obtained by the applicant form the "Free Online Dictionary of Computing" which defines an IRC is *structured as networks of Internet server*. It is respectfully noted that this argument is not persuasive, because there is simply nothing consistent between these two definitions.

14. Examiner has reviewed the overall prosecution and the direction of the response, and/or amendments that have been filed. Examiner respectfully presents proposed draft of claim 1 for applicant's consideration.

It is noted that examiner is not skilled in the claim draftsmanship nor intends to be, the proposed claims are explicitly drafted for the only purpose of explicitly pointing out specific subject matter for applicant's consideration along with an indication as to where this is described in the specification. Applicant is urged to rewrite the claims based on his/her expertise.



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15. The proposal is not an implied or explicit indication of allowable subject matter and is in its entirety subjected or contingent to further search and/or consideration.

16. Suggestion to the claim language: A method of displaying messages with a chat client in an information exchange system for transmitting and receiving the messages to and/or from at least two independent chat networks that are coupled to at least one chat server that provides independent chat communication service to the client, where a chat network comprises at least a communication or conversation between two or more users; where the chat client is in chat communication with the two chat networks concurrently over a period of time, the method comprising the steps of:

designating, with the chat client, at least one of the two chat networks as an active chat network for receiving messages transmitted by the chat client;

obtaining, with the chat client, the messages, at least some of which are transmitted to or received from a first of the least two chat networks designated as a main-channel, and at least some which are transmitted and received from a second of the at least two chat network designated as a sub-channel; and

displaying, with the chat client, the obtained messages designated as the main channel in a first discrete display area comprising a first window and the obtained messages designated as the sub-channel in a second discrete display area comprising a second window and

17. Further features to be considered for inclusion in this base claim are:

the messages transmitted and/or received comprise at least two or more of the following group: an IRC network name, the channel name, and the user, the message issuing time and the message content (p. 10, lines 3-8, 31-34); OR

designating a predetermined condition based on which the messages transmitted and/or received are displayed in said displaying step, where the predetermined condition comprises selectively displaying said messages based on the message issuing time or the lines of message content (p. 11, lines 11-16 and p.12, lines 3-5, 31-34).

18. Pertinent Prior Art: The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure; pertinence is presented in accordance with MPEP§ 707.05. Copies of Non-Literature documents cited will be provided:

TOURBUS: Internet Relay chat, Rankin, B. (Aug. 13, 1996). Rankin discloses an IRC (Internet Relay Chat) Internet service that is provided by a service provider (e.g. America Online or CompuServe),

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wherein the user connects or access the server and tunes in to a specific chat channel and participated in a live conversation with other user, transmitting and receiving (text) messages; wherein the (IRC) chat client connects to the IRC server serving as a host to chat; wherein the system enables the user connect to one or a list of alternative server if the default server is busy, the communication is SLIP/PPP based (this means the communication is IP based and therefore the communication links are based on the unique user IP address, i.e. service provided is an independent chat communication concurrently over a period of time while the users are connected to the server hosting the chat). Most importantly, it further teaches that the client software supports "multiple windows to display channel listings, command output, and dialog", on pages 1-2 at the least.

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (703) 305-0750. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Jack B. Harvey can be reached on (703) 305-9705. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free)).

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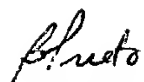
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VA, Sixth Floor (Receptionist).



B. Prieto

TC 2100

Patent Examiner

September 9, 2004